REMARKS

This paper is responsive to an Office Action mailed February 28, 2007. Prior to this response, claims 1-34 were pending. After amending claims 1, 6, 13-14, 17-18, 30-31, and 34, claims 1-34 remain pending.

In Section 1 of the Office Action objections have been made to the oath. It appears to the Applicant as if the signature pages of the Assignment and Declaration documents were switched when the application was initially filed. A copy of the original Declaration is enclosed, which meets the requirements of 37 CFR 1.67 and 1.68.

Objections are made in the Office Action to the drawings. In response, Replacement drawings are enclosed.

The Office Action has rejected claims 1, 3-6, 9-10, 17-18, 20-23, 26-27, and 34 under 35 U.S.C. 102(e) as anticipated by Wiegley (US 6,711,677). With respect to independent claims 1, 17, and 18, the Office Action states that Wiegley discloses all the elements of the claims. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Wiegley discloses a print session occurring between a computer 12 and a printer 10. A secure print job is initially requested by computer 12 (Step 102). In response to receiving the request from the computer, the printer 10 generates a session identifier 38a (Step 104),

which is stored in memory (col. 3, ln. 66 through col. 4, ln. 7). Next, the printer sends the session identifier and a public key to the computer (Step 106). The computer uses the public key to authenticate the printer (col. 4, ln. 30-42), Step 108. After the printer transmission is verified, the computer generates a secret encryption (session) key (Step 110). Using the printer's public key, the computer encrypts the session key and the session identifier (Steps 112 and 114). The print job is encrypted by the computer using the session key and sent to the printer (Steps 116 and 118). In Step 120, the printer decrypts the received session key using its private key. In Step 122 the printer compares the original session key to the decrypted session key, and if the keys match, the print job is processed in Step 126 (col. 4, ln. 47 through col. 5, ln 15).

For added security, the computer may generate a hash of the print job and encrypt it with the session key. The printer computes a hash value for the decrypted print job, and compares the computed hash value to the hash value received from the computer (col. 5, ln. 25-39).

Generally, Wiegley discloses a two-way communication process where link security is established in response to sending a session identifier to the node originating the print job, receiving a session identifier back in a reply, and comparing the received session identifier with the originally-sent identifier. In contrast, the claimed invention uses a one-way link between nodes – the claimed invention first device does not send a session identifier. Another general difference is that Wiegley's process is designed to protect a print job being transmitted from one node to another. The claimed invention is designed to securely access a resource that is already stored in the memory of the destination node.

More specifically, claim 1 recites receiving an unencrypted job. In contrast, Wiegley receives an encrypted print job. Wiegley does not disclose a printer that uses a received session key to decrypt a printer resource, as recited in claim 1, or the processing of the print job using the decrypted resource. The end result of Wiegley's process is the recovery of an encrypted transmission. The Applicant respectfully submits that a session identifier is not resource, since no processes can be performed on Wiegley's print job using a session identifier. Rather, the session identifier is simply a code (col. 4, ln. 8-13).

Claims 17 and 34 describe the process from the transmitter's (second node) point of view. Wiegley does not disclose the sending an unencrypted job, or processing the job at the receiving (first) node using an encrypted resource, as recited in claims 17 and 34.

Claim 18 recites a security unit that authorizes access to an encrypted resource in response to validating CH. As noted in detail above, Wiegley does not disclose the use of resources to process a print job, or a process of decrypting a resource stored in memory.

As noted above, Wiegley fails to recite the steps of transmitting an unencrypted job, decrypting a stored resource, or processing the job using the decrypted resource, as recited in claims 1, 17, 18, and 34. Since Wiegley does not explicitly disclose every limitation of claims 1, 17, 18, and 34, he cannot anticipate those claims. Claims 3-6 and 9-10, dependent from claim 1, and claims 20-23 and 26-27, dependent from claim 18, enjoy the same distinctions from the cited prior art, and the Applicant respectfully requests that the rejection be withdrawn.

The Office Action has rejected claims 2 and 19 under 35 U.S.C. 103(a) as unpatentable with respect to Wiegley. The Office Action acknowledges that Wiegley fails to disclose the encrypting of H' using K, obtaining CH', and comparing CH to CH'. The Office Action states that it would have been obvious to use the inverse of Wiegley's process to achieve equivalent results. This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Generally, the obviousness rejection is based upon the assumption that Wiegley discloses all the limitations of claims 1 and 18. However, as noted above in response to the anticipation rejection, Wiegley does not disclose the limitations of transmitting an unencrypted job, decrypting a stored resource, or processing the job using the decrypted resource. With respect to the third *prima facie* requirement, even if it would have been obvious to modify Wiegley's process to encrypt H' using K, obtain CH', and compare CH to CH', this modified version of Wiegley would still not explicitly disclose every limitation of claims 1 and 18.

Claim 2, dependent from claim 1, and claim 19, dependent from these claim 18, enjoy the same advantages.

With respect to the first *prima facie* requirement, the Office Action states it would have been obvious to "use the inverse of Wiegley's cryptography methods". However, no rationale is given to support this assumption. Further, even if this unsupported statement were correct, it does not explain how an expert in the art could have modified Wiegley in such a way as to describe all the claimed invention limitations. As explained above in response to the third *prima facie* requirement, even if it would have been obvious to modify Wiegley, the modified version of Wiegley fails to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could modify a system that uses a 2-way communication process to encrypt/decrypt a print job, into a one-way process for accessing encrypted resources at the receiving node. Rather, to meet the first *prima facie* requirement, there must be an explicit teaching in Wiegley that shows an expert how the Wiegley reference can be modified to yield the claimed invention. Neither does Wiegley disclose a need or desire to decrypt resources stored in the receiving node. Such a *prima facie* case has not been made, simply because all the Applicant's claim limitations cannot be found in the reference.

Alternately, if the Examiner is relying upon the knowledge of a person with skill in the art to supply motivation lacking the Wiegley reference, then additional evidence must be provided. Notable, when the source or motivation is not from the prior art references, "the evidence" of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied". *DyStar*, 464 F.3d at 1366, 80

USPQ2d at 1649. The Office Action has not supplied any explanation of how an expert could possible modify Wiegley to yield all the explicit limitations recited in the basé claims.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Wiegley invention as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 2 and 19 be removed.

The Office Action has rejected claims 11-16 and 28-33 under 35 U.S.C. 103(a) as unpatentable with respect to Wiegley in view of Slick et al. ("Slick"; US 7,003,667). The Office Action acknowledges that Wiegley fails to disclose a plurality of network-connected nodes, but that it would have been obvious "to accommodate the plurality of resources as embodied by Slick et al. [Figure 1]." This rejection is traversed as follows.

In Fig. 1 Slick shows personal computers connected to printers through a network.

The obviousness rejection is predicated upon the assumption that Wiegley discloses all the limitations of claims 1 and 18. However, as noted above in response to the anticipation rejection, Wiegley does not disclose the limitations of transmitting an unencrypted job, decrypting a stored resource, or processing the job using the decrypted resource. With respect to the third *prima facie* requirement, even if it would have been obvious to modify Wiegley's process to incorporate a plurality of network-connected nodes, this modified version of Wiegley would still not explicitly

disclose every limitation of claims 1 and 18. Claims 11-16, dependent from claim 1, and claims 28-33, dependent from these claim 18, enjoy the same advantages.

With respect to the first *prima facie* requirement, the Office Action states it would have been obvious to "to accommodate the plurality of resources as embodied by Slick et al. [Figure 1]." Again, no rationale is given to support this assumption. However, even if this statement were correct, it does not explain how an expert in the art could have modified Wiegley in such a way as to describe the claimed invention. As explained above in response to the third *prima facie* requirement, even if it would have been obvious to combine Slick with Wiegley, the combination fails to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could modify a system that uses a 2-way communication process to encrypt/decrypt a print job, into a one-way process for accessing encrypted resources at the receiving node. Rather, to meet the first *prima facie* requirement, there must be an explicit teaching in the Slick reference that shows an expert how the Wiegley reference can be modified to yield the claimed invention. Such a *prima facie* case has not been made, because all the Applicant's claim limitations cannot be found in the two references.

Alternately, if the Examiner is relying upon the knowledge of a person with skill in the art to supply motivation lacking the Wiegley reference, then additional evidence must be provided. The Office Action has not supplied any explanation of how an expert could possible modify Wiegley to yield all the explicit limitations recited in the base claims.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Slick and Wiegley disclosures as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 11-16 and 28-33 be removed.

The Office Action has rejected claims 7-8 and 24-25 under 35 U.S.C. 103(a) as unpatentable with respect to Wiegley in view of Konsella et al. ("Konsella"; US 6,856,317). The Office Action acknowledges that Wiegley fails to disclose storing an encrypted font resource, but that Konsella teaches a method for storing public and secure font data, and that it would have been obvious "to incorporate secure font data files as part of the encrypted resources in Wiegley's secured printing method." This rejection is traversed as follows.

Konsella discloses a process for storing public font data together with encrypted (secure) font data in a file (col. 2, ln. 54-63).

The obviousness rejection is predicated upon the assumption that Wiegley discloses all the limitations of claims 1 and 18. However, as noted above in response to the anticipation rejection, Wiegley does not disclose the limitations of transmitting an unencrypted job, decrypting a stored resource, or processing the job using the decrypted resource. With respect to the third *prima facie* requirement, even if it would have been obvious to modify Wiegley's process to incorporate a the storage of public fonts together with encrypted fonts, this modified version of Wiegley would still not explicitly disclose every limitation of claims 1 and 18.

Claims 7-8, dependent from claim 1, and claims 24-25, dependent from these claim 18, enjoy the same advantages.

With respect to the first *prima facie* requirement, the Office Action states it would have been obvious to "to incorporate secure font data files as part of the encrypted resources in Wiegley's secured printing method." However as noted above, Wiegley is absolutely on the subjects of storing encrypted resources, or accessing encrypted resources. Further, even if Wiegley did disclose encrypted resources, no rationale has been provided to support the assumption that it would have been obvious to incorporate Konsella's fonts. Finally, even if it would have been obvious to incorporate Konsella's fonts, no rationale has been provided to explain how an expert in the art could have modified Wiegley in such a way as to describe the claimed invention limitations missing in the combination of Wiegley plus Konsella. As explained above in response to the third *prima facie* requirement, even if it would have been obvious to combine Konsella with Wiegley, the combination fails to disclose all of the claimed invention limitations. The above-quoted statement from Office Action does not explain how even a person with skill in the art could modify a system that uses a 2-way communication process to encrypt/decrypt a print job, into a one-way process for accessing encrypted resources at the receiving node. Rather, to meet the first *prima facie* requirement, there must be an explicit teaching in the Konsella reference that shows an expert how the Wiegley reference can be modified to yield the claimed invention. Such a *prima facie* case has not been made, because all the Applicant's claim limitations cannot be found in the two references.

Alternately, if the Examiner is relying upon the knowledge of a person with skill in the art to supply motivation lacking the Wiegley

reference, then additional evidence must be provided. The Office Action has not supplied any explanation of how an expert could possible modify Wiegley to yield all the explicit limitations recited in the base claims.

Considered from the perspective of the second *prima facie* requirement, even if an expert were given the Konsella and Wiegley disclosures as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention.
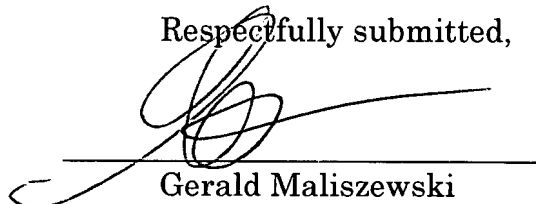
In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported, and the Applicant requests that the rejection of claims 7-8 and 24-25 be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

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